

Notice of Allowability

Application No.

10/723,606

Applicant(s)

PALKA-HAMBLIN ET AL.

Examiner

Tekchand Saidha

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 25 September 2006.
2. ☒ The allowed claim(s) is/are 18-25.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 07/08/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

Notice of Allowability

1. Applicant's election of Group 28, claims 18-25 in the reply filed on 25 September 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Applicants' Information Disclosure Statement [IDS], PTO-1449, filed July 8 2004, is acknowledged. A signed copy of the IDS is provided here.
3. Claims 18-25 are pending and under consideration.
4. Claims 18-25 are allowed, subject to the following Examiner's Amendment.
5. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given by Mae Joanne Rosok, on November 3, 2006.

Amendments the specification are as follows:

On page 15, line 28, at the beginning of the sentence delete internet hyper-link 'URL:http://www.'

On page 18, line 16, delete internet hyper-link 'URL:http://www.'

On page 18, line 20, delete internet hyper-link 'URL:http://www.'

On page 18, line 24, delete internet hyper-link 'URL:http://www.'

On page 18, line 28, delete internet hyper-link 'URL:http://www.'

Cancel claims 1-17

Amendments to the claims are as follows:

Claim 18, page 83, line 3, delete 'DEP-1' and replace with 'density enhanced phosphatase-1 (DEP-1)'.

Claim 18(c), page 83, line 13, after 'moderately stringent conditions' insert ", wherein moderately stringent conditions comprise prewashing in a solution of 5 X SSC, 0.5% SDS, 1.0 mM EDTA (pH 8.0) and hybridizing at 50°C-70°C, 5 X SSC, for 1-16 hours".

Claim 18(d), page 83, line 16, delete "or a variant thereof,".

Claim 18(k), page 84, line 6, after 'moderately stringent conditions' insert ", wherein moderately stringent conditions comprise prewashing in a solution of 5 X SSC, 0.5% SDS, 1.0 mM EDTA (pH 8.0) and hybridizing at 50°C-70°C, 5 X SSC, for 1-16 hours".

Claim 18(ii(a)), page 84, line 16, after 'SEQ ID NOS:4-6,', insert 'and'.

Claim 18(ii(b)), page 84, line 19, after 'polypeptide of (a)', delete ',' and replace with '.' and delete rest of the sentence or lines 20-23.

Claim 21(c), (page 85), line 14, after 'moderately stringent conditions' insert ", wherein moderately stringent conditions comprise prewashing in a solution of 5 X SSC, 0.5% SDS, 1.0 mM EDTA (pH 8.0) and hybridizing at 50°C-70°C, 5 X SSC, for 1-16 hours".

Claim 21(d), page 85, line 17, delete "or a variant thereof,".

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Claim 21(k), page 86, line 10, after 'moderately stringent conditions' insert ", wherein moderately stringent conditions comprise prewashing in a solution of 5 X SSC, 0.5% SDS, 1.0 mM EDTA (pH 8.0) and hybridizing at 50°C-70°C, 5 X SSC, for 1-16 hours".

Claim 21(iv(a)), page 86, line 19, after 'SEQ ID NOS:4-6,', insert 'and'.

Claim 21(iv(b)), page 86, line 22, after 'polypeptide of (a)', delete ',' and replace with '.' and delete rest of the sentence or lines 23-26.

6. The following is an examiner's statement of reasons for allowance:

This Application provides a novel method for altering transduction of biological signal in a cell by introducing into a cell a density enhanced polypeptide that is capable of specific association with a DEP-1 substrate polypeptide for a time specific in order to form a complex wherein transduction of the biological signal is made possible by altered cell proliferation, differentiation or survival.

The closest prior art works of Tonks et al. [WO 95/30008 (1995) cited in Applicants' IDS] teach various density enhanced protein tyrosine phosphatases or substrate trapping mutants (USP 5,912,138 or USP 5,951,979, cited in Applicants' IDS), however, do not teach the proposed combination of method steps for altering transduction of a biological signal in a cell or provide motivation to one of ordinary skill in the art to use the skills available in the area of enzymology or molecular biology, to make the invention obvious.

7. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to

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avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

8. Drawing filed 11/26/2003 is acknowledged and are acceptable for examination purposes.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tekchand Saidha (Ph.D.) whose telephone number is (571) 272-0940. The examiner can normally be reached on Monday-Friday from 8:15 am to 4:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (571) 272-0928. The fax phone number for this Group in the Technology Center is 703 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is 571 272-1600.



Tekchand Saidha
Primary Examiner, Art Unit 1652
Recombinant Enzymes, 02A65 Remsen Bld.
400 Dulany Street, Alexandria, VA 22314
Telephone : (571) 272-0940
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